

**REMARKS****Rejections under 35 USC §103(a)**

A. Claims 1-2, 4-5, 9-12, 19-20 and 22 have been rejected under 35 USC §103(a) as being unpatentable over Cioca et al. (US Patent No. 6,451,328) in view of Beerse et al. (US Patent No. 6,217,887) and further in view of Stroud et al. (US Patent No. 6,231,837).

Applicants believe the rejection to be in error, and request reconsideration for the following reasons. As the Examiner does note, none of these references mentions silver ion and potassium sorbate as antimicrobials integrated within a cluster structure.

With regard to Cioca, the rejection states, in part:

Cioca et al. teach a cosmetic or pharmaceutical composition comprising structured water having at least one biologically active agent, an antioxidant integrated within at least one cluster structure. The structured water comprises a combination of I and S water.....  
Cioca et al. do not expressly teach silver ion and potassium sorbate as biologically active agents,... antimicrobials integrated within cluster structure.

With regard to Beerse et al., the rejection states:

Beerse et al. teach leave-on anti-microbial compositions which provide improved immediate germ reduction. Silver is a known active antimicrobial agent according to Beerse.

With regard to Stroud et al., the rejection states:

Stroud et al. teach cosmetic compositions. Potassium sorbate is disclosed as an antibacterial agent in cosmetic compositions.

As to the combination, the rejection states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ silver as an antimicrobial in the composition of Cioca et al. and integrate within the cluster structure of structured water .....

The Examiner has failed to provide any evidence in these references that it is desirable to combine any antimicrobial with a structured cluster of structured water with the properties claimed therein. Therefore, when the totality of the teachings of all the cited references is combined, there is still no suggestion of a composition combining the claims of the present invention, as amended. To re-emphasize the arguments previously presented, the claims are directed to two antimicrobial agents of the silver ion and the potassium sorbate which are

integrated within the cluster structure of the structured water. Herefore, the two antimicrobial agents have been found to work together in the integration of the silver ion into the clusters of the structured water and is therefore, a distinct and different system than each or all of the cited references.

Although arguably, a plethora of antimicrobials and biological agents are named in literature; for example, potassium sorbate is a known anti-microbial and the Cioca reference teaches anti-oxidants; certainly the functional activities of one type of biological agent can not be extrapolated from the activities of another. In the present invention, the rejection fails to take into consideration the unexpected results observed by Applicants in the integration of two antimicrobial agents of the silver ion and the potassium sorbate within the cluster structure of the structured water. Even if one reads the references in a light most favorable to the Examiner's arguments, and assumes *arguendo*, that a *prima facie* case of obviousness has been made, any such position is immediately rebutted by the surprising results, namely that the integration of the silver ion and potassium sorbate into the clusters of the structured water renders the silver ion in a more stable form than silver ion merely added to the structured water.

More importantly, the integration of the silver ion and potassium sorbate into the clusters of the structured water has improved properties relative to the composition that simply contains silver ions and potassium sorbate mixed together. Even if it could be said that the prior art might suggest the combination of silver ions and potassium sorbate, because both are antimicrobials, the examples cited in the specification show that the mere mixture in the feed water, without treatment, achieves little antimicrobial activity, while their mixture in the structured water cluster achieves a very active antimicrobial composition. There is nothing in any of the cited documents, either alone or in combination, which would suggest or predict this property of the silver ion and potassium sorbate within the cluster structure of the structured water.

An analysis of obviousness of a claimed combination must include consideration of the results achieved by the combination. *Gillette Co. v S.C. Johnson & Son*, 16 USPQ 2d 1923 (Fed. Cir. 1990). In view of the unexpected results obtained in the claimed combination, which results are not taught or suggested by the prior art, withdrawal of this rejection is respectfully requested.

B. In reference to [Claims 19, 21-22 (sic)], it should be Claims 19-20 and 22; the Examiner contends that the inherent properties of the compound and its properties are

inseparable. While this may be true, this does not address the properties of a composition which exhibits properties that are unique and improved relative to the properties of the individual components of the composition. Further, however, Applicants would also like to emphasize that the claims in question are a method of use of the pertinent compounds, and not a composition claim. The discovery of new properties of a compound or combination of compounds, even if the compounds are known, is unequivocally relevant to the patentability of a method of use of such compositions. The unexpected properties observed with the present compositions must be taken into consideration in determining the patentability of the method claims. Indeed, *In re Papesch*, 137 USPQ 43 (CCPA 1963), the case cited by the Examiner as supporting the PTO position, if read in its totality, stands for exactly for this proposition. Attention is drawn in *Papesch* to the exact paragraph from which the Examiner's citation is drawn. This paragraph, *in toto*, reads as follows:

From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing. The graphic formulae, the chemical nomenclature, the systems of classification and study such as the concepts of homology, isomerism, etc., are mere symbols by which compounds can be identified, classified, and compared. But a formula is not a compound and while it may serve in a claim to *identify* what is being patented, as the metes and bounds of a deed identify a plot of land, the *thing* that is patented is not the formula but the compound identified by it. And the patentability of the thing does not depend on the similarity of its formula to that of another compound but of the similarity of the former compound to the latter. There is no basis in law for ignoring any property in making such a comparison. An assumed similarity based on a comparison of formulae must give way to evidence that the assumption is erroneous. (*Papesch at 52; emphasis added*)

Therefore, it is clear that *Papesch* specifically adopts the position that Applicants have taken, i.e., that the properties of the compounds in question must be taken into consideration in determining patentability. If this is pertinent to the patentability of the composition, then it is certainly pertinent to a method of using that composition.

Further, Applicants note the Examiner's comments regarding the patentability of product-by-process claims, in proximity to the rejection of Claims 19-20 and 22. Applicants note that these claims are not product by process claims, so it is not clear that this argument relates to any existing claim in the application. However, in the event the Examiner interprets any pending claim as a product-by-process claim, it is noted that previously, the Applicants have shown by way of the Manzatu declaration that the product made by the method disclosed in the specification is different from the compositions actually described by the art, and from those the

Examiner says would be suggested by prior art. Therefore, an product by process claims in the present case meet the standards of patentability for such claims.

Further, the Examiner dismisses the Manzatu declaration as irrelevant, but it stands for an important point, regardless of what is cited as prior art; it shows that the addition of a material to structured water does not result in incorporation of that material into the clusters of structured water. The declaration also supports the argument presented in Item A.

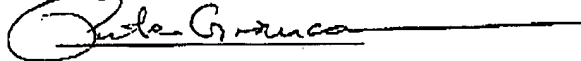
Therefore, in view of the surprising results, namely, the improved antimicrobial properties achieved by the combination of silver and potassium sorbate incorporated into the structured water clusters, the unexpected results achieved by the method for its use must be considered in determining the patentability of the method. In view of the unexpected results, withdrawal of the rejection of claims 1-2, 4-5, 9-12, 19-20 and 22 is respectfully requested.

C. Further in light of an earlier acknowledgement by the Applicants of the Examiner's provisional double patent rejection of Claims 1, 4, 5, 9, 11 to 20 and 22 as being unpatentable over Claims 1-5 of copending Application No. 10/183819, Applicants will make a terminal disclaimer, if necessary, in the event that allowable subject matter is indicated.

#### CONCLUSION

The present claims are believed to be in condition for allowance, and prompt issuance of a Notice of Allowance is respectfully solicited. The Examiner is encouraged to contact the undersigned by telephone if it is believed that discussion will resolve any outstanding issues.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Peter Giancana", is written over a horizontal line.

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